



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,067	11/19/2003	Chhman Sukhna	P/1281-121	7234
2352	7590	02/01/2006	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 02/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/717,067	Applicant(s) SUKHNA, CHHMAN	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-21 and 23-25 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicant's amendment filed 11/25/05.

The new grounds of rejection set forth below are necessitated by applicant's amendment and thus, the following action is final.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-21 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 and claim 23 have each been amended to recite "at least the dimethicone copolyol and the polymeric particles are cohesively bonded to one another to provide a substantially homogeneous non-settling ink composition". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the phrase "substantially homogeneous" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the above amendment, applicants point to page 2, lines 9-13 and page 8, lines 4-8 of the specification as originally filed. However, while these portion of the specification provide support to recite that the dimethicone copolyol and the polymeric particles are cohesively bonded to one another to provide a “homogeneous” non-settling ink composition, there is no support to recite that the dimethicone copolyol and the polymeric particles are cohesively bonded to one another to provide a “substantially homogeneous” non-settling ink composition. While there is support in the specification as originally filed to recite “homogeneous, there appears to be no support in the specification as originally filed to recite “substantially homogeneous” as recited in the above cited phrase.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-21 and 23-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and claim 23 have each been amended to recite “at least the dimethicone copolyol and the polymeric particles are cohesively bonded to one another to provide a substantially homogeneous non-settling ink composition”. The scope of the claim is confusing because it is not clear what is meant by “substantially” homogenous or how or when the ink is considered “substantially” homogeneous. Clarification is requested.

**Claim Rejections - 35 USC § 102**

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-2, 4-9, 11-14, 17-18, 21, 23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyamoto et al. '435 (U.S. 6,492,435) taken in view of the evidence given in Miyamoto et al. '099 (U.S. 6,451,099).

The rejection is adequately set forth in paragraph 4 of the office action mailed 8/24/05 and is incorporated here by reference.

With respect to amended claim 21, it is noted that Miyamoto et al. '435 disclose the sue of dimethicone copolyol that is silicone copolymer.

Further, with respect to the amendment to claims 1 and 23, it is noted that given that Miyamoto et al. '435 disclose dimethicone copolyol and submicron polymeric particles, i.e. hollow microsphere, identical to that presently claimed, it is clear that the dimethicone copolyol and submicron polymeric particles would inherently cohesively bond to another to provide a substantially homogeneous non-settling ink.

**Claim Rejections - 35 USC § 103**

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (U.S. 6,492,435) in view of Wang et al. (U.S. 5,769,931).

The rejection is adequately set forth in paragraph 6 of the office action mailed 8/24/05 and is incorporated here by reference.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (U.S. 6,492,435) in view of Imagawa et al. (U.S. 5,716,217).

The rejection is adequately set forth in paragraph 7 of the office action mailed 8/24/05 and is incorporated here by reference.

11. Claims 1, 3-4, 6-12, 18-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loria et al. et al. (U.S. 4,880,465) in view of Takemoto et al. (U.S. 6,827,433).

The rejection is adequately set forth in paragraph 9 of the office action mailed 8/24/05 and is incorporated here by reference.

With respect to amended claim 21, it is noted that Takemoto et al. disclose the use of dimethicone copolyol that is silicone copolymer.

Further, with respect to the amendment to claims 1 and 23, it is noted that given that Loria et al. et al. in combination with Takemoto et al. disclose dimethicone copolyol and submicron polymeric particles, i.e. hollow microsphere, identical to that presently claimed, it is clear that the dimethicone copolyol and submicron polymeric particles would intrinsically cohesively bond to another to provide a substantially homogeneous non-settling ink.

Art Unit: 1714

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loria et al. et al. in view of Takemoto et al. as applied to claims 1, 3-4, 6-12, 18-19, and 21 above, and further in view of Imagawa et al. (U.S. 5,716,217).

The rejection is adequately set forth in paragraph 10 of the office action mailed 8/24/05 and is incorporated here by reference.

13. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loria et al. et al. in view of Takemoto et al. as applied to claims 1, 3-4, 6-12, 18-19, and 21 above, and further in view of Beach et al. (U.S. 6,309,452).

The rejection is adequately set forth in paragraph 11 of the office action mailed 8/24/05 and is incorporated here by reference.

14. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loria et al. et al. in view of Takemoto et al. as applied to claims 1, 3-4, 6-12, 18-19, and 21 above, and further in view of Pearlstine et al. (U.S. 6,087,416).

The rejection is adequately set forth in paragraph 12 of the office action mailed 8/24/05 and is incorporated here by reference.

15. Claims 1-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imagawa et al. (U.S. 5,716,217) in view of Loftin (U.S. 5,338,793) and Tanaka et al. (U.S. 2003/0228430).

The rejection is adequately set forth in paragraph 13 of the office action mailed 8/24/05 and is incorporated here by reference.

With respect to amended claim 21, it is noted that Loftin discloses the use of dimethicone copolyol that is silicone copolymer.

Further, with respect to the amendment to claims 1 and 23, it is noted that given that Imagawa et al in combination with Loftin disclose dimethicone copolyol and submicron polymeric particles, i.e. hollow microsphere, identical to that presently claimed, it is clear that the dimethicone copolyol and submicron polymeric particles would intrinsically cohesively bond to another to provide a substantially homogeneous non-settling ink.

#### **Response to Arguments**

16. Applicant's arguments filed 11/25/05 have been fully considered but they are not persuasive.

Specifically, applicant argues that Miyamoto et al. '435 is not a relevant reference against the present claims given that Miyamoto et al. '435 refers to ballpoint pen ink which unlike the formulation of the present invention does not work in wick style marker or free ink system marker. Applicants argue that the high viscosity of the ink of Miyamoto et al. '435, i.e. 6,000-100,000, would not allow the ink to work in such markers.

However, there is no requirement in the present claims that the ink is used in wick style marker or free ink system marker. Present claim 1 only requires that the ink is "suitable for use in markers". On the one hand, given the broad disclosure of marker, it is clear that such disclosure is broad enough to encompass any marking instrument including ballpoint pen. On the



other hand, the recitation in the claims that the ink is “suitable for” use in markers is merely an intended use. Applicant’s attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner’s position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Miyamoto et al. ‘435 disclose ink as presently claimed, it is clear that the ink of Miyamoto et al. ‘435 would be capable of performing the intended use, i.e. for markers, presently claimed as required in the above cited portion of the MPEP. Further, present claim 23 only requires the use of marking instrument comprising nib and reservoir. It is noted that ballpoint pens comprise both nib and reservoir.

Applicant argues that the high viscosity of the ink of Miyamoto et al. ‘435 would not allow the ink to function in either wick style marker or free ink system marker. However, as set forth above, there is no requirement in the present claims that the ink is used in such markers. However, even if such limitation were present, it is noted that the viscosity pointed to by applicants in Miyamoto et al. ‘435, i.e. 6,000-10,000 MPas, refers to the viscosity of a prior ink not the ink of Miyamoto et al. ‘435. The viscosity of the ink of Miyamoto et al. ‘435 is disclosed as 500-5,000 mPas (col.2, lines 42-44 and col.5, lines 36-46). Additionally, while applicants argue that the ink of Miyamoto et al. ‘435 has viscosity such that the ink cannot function in wick style marker or free ink system marker, applicants offer no evidence to support this position. It is

noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”.

Applicant argues that the presently claimed formulation lacks the jelly-like structure disclosed by Miyamoto et al. ‘435 to prevent settling and that in the present invention, the dimethicone copolyol and submicron polymeric particles are cohesively bonded to one another so as to produce a substantially homogeneous non-settling ink.

However, while Miyamoto et al. ‘435 do disclose that a thickener is utilized to inhibit titanium dioxide from settling and provide ink with suitable fluidity, there appears to be no disclosure that the ink of Miyamoto et al. ‘435 has jelly-like structure. While it is agreed that there is no disclosure in Miyamoto et al. ‘435 that the dimethicone copolyol and submicron polymeric particles are cohesively bonded to one another, given that Miyamoto et al. ‘435 disclose the use of dimethicone copolyol and submicron polymeric particles, i.e. hollow microsphere, identical to that presently claimed, it is clear that the dimethicone copolyol and submicron polymeric particles would inherently cohesively bond to another to provide a substantially homogeneous non-settling ink.

Applicant also argues that Miyamoto et al. ‘435 utilizes titanium dioxide which is not utilized in the present invention due to settling problems. However, in light of the open language of the present claims, i.e. “comprising”, it is clear that the claims are open to the inclusion of additional ingredients including titanium dioxide.

Applicant argues that Wang et al. is not a relevant reference against the present claims given that there is no disclosure in Wang et al. of the use of hollow microspheres and/or the use of dimethicone copolyol to suspend the microspheres. However, Wang et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the use fluorinated surfactants in inks to provide acceptable delivery rate of ink to substrate, and in combination with the primary reference, discloses the presently claimed invention.

Applicant also argues that the ink of Wang et al. will not work in the wick of a capillary action system and/or free ink system which is the use of the contemplated for the presently claimed formulation.

However, there is nothing in the scope of the present claims which requires that the ink is suitable for use in the wick of the capillary action system and/or free ink system and thus, no requirement that Wang et al. meet such limitation.

Applicant argues that Imagawa et al. is not a relevant reference against the present claims given that Imagawa et al. is drawn to ink for neon boards or lighted boards wherein the ink comprises carboxylic acid ester and further given that there is no mention of a need to suspend or prevent the hollow microsphere present in the ink from settling and no disclosure of dimethicone

copolyol and submicron polymeric particles that cohesively bond to another to provide a substantially homogeneous non-settling ink.

With respect to the rejections of record utilizing Imagawa et al. in view of Loftin and Tanaka et al., while it is agreed that Imagawa et al. is drawn to ink for application on neon boards or lighted boards, there is nothing in the scope of the present claims which excludes using the ink in such manner. The present claims only require ink suitable for use in markers (claim 1) or marking instrument comprising nib and reservoir containing the ink (claim 23) which are each met by Imagawa et al. which disclose ink for markers wherein the markers comprise nib and reservoir.

Additionally, while it is agreed that Imagawa et al. requires the use of carboxylic acid ester not required in the present claims, it is noted that in light of the open language of the present claims, i.e. "comprising", the use of such carboxylic acid ester is clearly not excluded from the scope of the present claims.

Although there is no disclosure that the dimethicone copolyol and hollow microspheres are cohesively bonded to each other to provide a substantially homogeneous non-settling ink, given that Imagawa et al in combination with Loftin disclose dimethicone copolyol and submicron polymeric particles, i.e. hollow microsphere, identical to that presently claimed, it is clear that the dimethicone copolyol and submicron polymeric particles would intrinsically cohesively bond to another to provide a substantially homogeneous non-settling ink.

Applicants also argue that there is no motivation to utilize dimethicone copolyol in Imagawa et al. given that Imagawa et al. already teaches the use of hollow microspheres that will not coagulate or settle.

However, while Imagawa et al. disclose that the hollow microspheres will not settle, it is noted that the motivation for using dimethicone disclosed by Loftin to wet substrate and improve erasability of the ink. Although the motivation to combine is not the same motivation for using dimethicone copolyol in the present invention, it is noted that obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

Applicant argues that Loftin is not a relevant reference against the present claims given that there is no disclosure of hollow microspheres in Loftin. However, Loftin et al. is a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the use of dimethicone copolyol in inks, and in combination with the primary reference, discloses the presently claimed invention.

Further, when Imagawa et al. is used in combination with Loria et al. and Takemoto et al., it is noted that while there is no disclosure in Imagawa et al. of dimethicone copolyol and submicron polymeric particles that cohesively bond to another to provide a substantially homogeneous non-settling ink, this is already taught by Loria et al. In this combination, it is noted that Imagawa et al. is a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the use of alcohol in

Art Unit: 1714

writing inks in order to produce ink that readily dries, and in combination with the primary reference, discloses the presently claimed invention.

Applicant argues that Loria et al. et al. and Takemoto et al. are not relevant references against the present claims given that each are drawn to ink jet ink while applicants do not propose to use the presently claimed ink as ink jet ink.

It is agreed that Loria et al. and Takemoto et al. are each drawn to ink jet inks. However, the recitation in present claim 1 that the ink is "suitable for" use in markers is merely an intended use. Applicant's attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Loria et al. in combination with Takemoto et al. disclose ink as presently claimed, it is clear that such ink would be capable of performing the intended use, i.e. for markers, presently claimed as required in the above cited portion of the MPEP. Further, it is noted that while present claim 23 requires the use of marking instrument comprising nib and reservoir, Loria et al. is not applied against present claims 23-25.

Applicant argues that there is no disclosure in Loria et al. of dimethicone copolyol to prevent settling problem as presently claimed. It is agreed that Loria et al. do not disclose

dimethicone copolyol which is why Loria et al. is used in combination with Takemoto et al. which disclose the use of presently claimed dimethicone copolyol. Given that Loria et al. et al. in combination with Takemoto et al. disclose dimethicone copolyol and submicron polymeric particles, i.e. hollow microsphere, identical to that presently claimed, it is clear that the dimethicone copolyol and submicron polymeric particles would intrinsically cohesively bond to another to provide a substantially homogeneous non-settling ink.

While there is no disclosure in Takemoto et al. of hollow microspheres as presently claimed, note that Takemoto et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the use of dimethicone copolyol in ink jet inks produces inks that do not cause color bleed or uneven printing, and in combination with the primary reference, discloses the presently claimed invention.

Applicants argue that Beach et al. is not a relevant reference against the present claims given that Beach et al. refers to printing inks that require wet-rub resistance that is not required with the presently claimed ink and given that there is no disclosure in Beach et al. of dimethicone copolyol.

However, there is nothing in the present claims which excludes the ink from having wet rub resistance. Further, while there is no disclosure in Beach et al. of dimethicone copolyol, note that Beach et al. is used as teaching reference, and therefore, it is not necessary for this secondary

reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, the use of glycol humectant in ink jet inks, as disclosed by Loria et al., and in combination with the primary reference, discloses the presently claimed invention.

Applicant also argues that Beach et al. is not a relevant reference against the present claims given that Beach et al. apply heat and pressure to cure the ink onto substrate which is not required in the present invention. However, it is noted that the application of heat and pressure to the printed ink is not required in Beach et al. While one embodiment of Beach et al. discloses using heat and pressure to cure the ink, it is not required in all embodiments.

Applicant argues Pearlstine et al. is not a relevant reference against the present claims given that there is no disclosure of hollow microspheres in Pearlstine et al. However, it is noted that Pearlstine et al. is a teaching reference, and therefore, it is not necessary for this secondary references to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this references teaches a certain concept, namely, the use of fluorocarbon surfactants in inks, and in combination with the primary reference, discloses the presently claimed invention.

Applicant also argues that the fluorosurfactant used in Pearlstine et al. is used to provide wetness and not to suspend colored pigment. Although the motivation to combine disclosed by Pearlstine et al. is not the same motivation as in the present invention, it is noted that



obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

Applicant argues that Tanaka et al. is not a relevant references against the present claims given that Tanaka et al. is drawn to thermal transfer printing and has no relationship to markers and/or writing instruments.

It is agreed that Tanaka et al. is drawn to thermal printing and not ink for markers. However, Tanaka et al. is only used to teach the meaning of a specific tradename already disclosed by Imagawa et al., namely, OP-84J.

### **Conclusion**

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

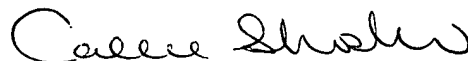
Art Unit: 1714

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
1/27/06